

Office Action Summary

Application No.

10/849,991

Applicant(s)

BURGO, ROCCO

Examiner

Lakshmi S. Channavajjala

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SD/US)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 10-31-08
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt of amendment to the specification and remarks dated 4-9-08 is acknowledged.

Claims 1-14 are pending in the instant application.

In response to applicants' inquiry regarding the final action dated 7-29-08 (see attached interview summary), the final rejection of 7-29-08 has been vacated and a new rejection has been issued.

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has complied with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e).

The following rejections of record have been maintained:

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5-11 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by either one of US 5,833,961 or US 5,989,527 to Siegfried et al (Siegfried).

The disclosures of the above US patents to Siegfried are similar and therefore the disclosure of '961 is relied upon for the teachings. '961 disclose a polyester based sunscreen composition comprising polyol polyesters and sunscreen active agents. The exemplified compositions do not contain any silicone fluids and hence meet the

negative limitation of claim 1. For the polyol polyesters, '961 teach that the polyester is a reaction product of at least one linear or branched aliphatic compound having two OH (diol) groups and at least one linear or branched chain aliphatic dicarboxylic acid and the diol may contain 2 to 10 ether linkages (col. 3, L 45-54). '961 further describes that the carboxylic acids contain 2 to 20 carbon atoms (col. 4, L 15-25) and the diols such as those recited in instant claim (col. 4, L30-45). For the preparation of the polyester, see lines bridging col. 4-5. Instant claim 8 does not recite any method and instead only recites a composition, which is taught by '961. For claims 5 and 13, '961 describe formula I, which meets the instant claimed formula. Therefore, the above patents of Siegfried anticipate instant claims.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of US 5,833,961 or US 5,989,527 to Siegfried et al (Siegfried).

The disclosures of the above US patents to Siegfried are similar and therefore the disclosure of '961 is relied upon for the teachings. '961 disclose a polyester based sunscreen composition comprising polyol polyesters and sunscreen active agents. The teachings of the above patents are described above. Instant claims 4 and 12 recite specific carboxylic acids that form the polyester. While neither of the Siegfried patents

mentioned above describe polyesters having only those claimed carboxylic acids, Siegfried states that their polyesters formed from a reaction of a diol and a diacid may further have the terminal end groups functionalized by reacting with a monofunctional acid having 2 to 40 carbon atoms such as propionic acid, butyric acid etc (col. 5, L 53 through col. 6, L20). Instant claims do not exclude polyol polyester that is a reaction product of diol and a diacid and also a monofunctional acid. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare polyol polyester containing both a monofunctional carboxylic acid as well as a diacid and still expect an effective sunscreen composition would have been within the scope of a skilled artisan because Siegfried teaches that the polyester compounds are effective in reducing the degree of penetration of the sunscreen composition through the outer stratum with the compounds having their end groups left as is or further functionalized.

Response to Arguments

4. Applicant's arguments filed 4-9-08 have been fully considered but they are not persuasive. Applicants' argue that "Siegfried '961 is directed to polyester based sunscreen formulations containing functionalized polyesters and at least two organic active sunscreen ingredients. None of the polyesters disclosed in Siegfried '961 has the specific structure of Formula I as claimed. With respect the argument, '961 teaches that the polyester is a reaction product of at least one diol, one diacid and a functionalized polyol or polyester. '961 further states that the polymer is a glycerin; diethylene glycol

and adipate (see col. 2). The polyesters thus read on the instant claimed polyol polyesters and applicants have not shown how the polyol polyesters of '961 are different from the instant claimed. It is argued that Siegfried '961 has not identified the disclosed polyesters as having use as a replacement for low viscosity silicone fluids in personal care compositions, even though the examples of Siegfried '961 do not include a low viscosity silicone fluid, Siegfried '961 does not teach or suggest expressly that low viscosity silicone fluids should be omitted. It is argued that the invention as claimed is directed to compositions to replace the lower viscosity silicone fluid in conventional personal care composition or methods of preparing personal care products while retaining the skin feel and consistency attributes of personal care products that contain low viscosity silicone fluids. Moreover, a person of skill in the art would have had no apparent reason to modify either of the Siegfried to arise at the invention as claimed. Applicants' arguments are not persuasive because instant claims require that the composition be free of low viscosity silicone fluids, which is met by the teachings of '961. For the claimed replacement, even though '961 does not teach the limitation, '961 does not teach inclusion of such silicone and thus the teachings of '961 meet the structural limitations of instant claims and further would achieve the same benefits With respect to optimization argued, argued by applicants, irrespective of whether the references recognizes the benefits.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
October 31, 2008